

Patent
Atty. Dkt. No. LYNN/0119

REMARKS

Pursuant to the restriction requirement imposed by the Examiner, Applicant elects to prosecute the claims of the invention of Group I as set forth in the Office Action dated July 23, 2004. Claims 58-64 are, therefore, hereby withdrawn from consideration as being drawn to the non-elected invention.

Claims 79-93 stand rejected under 35 U.S.C. 112, first paragraph, because the Examiner has determined that the specification, while enabling for "a strontium/rubidium separation factor greater than 12,500 at an alkaline pH," does not reasonably provide enablement for "a strontium/rubidium separation factor greater than 12,500." Applicant has cancelled claim 79 and amended claims 80 and 84-93 to depend, either directly or indirectly, from claim 1. Reconsideration and withdrawal of the rejection of claims 80-93 is respectfully requested.

Claims 1-3, 5, 79-93 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the instantly recited Honeywell sodium nonatitanate and also stand rejected under 35 U.S.C. 103(a) as being unpatentable over the AlliedSignal (now Honeywell) International Patent Application WO 97/14652 of Cahill, *et al.*

The Examiner has asserted that Cahill (pp.35, 38 and abstract) and a reference in the present specification to a Honeywell product (Specification, pages 9 and 16) suggest that the instantly claimed support medium comprising sodium nonatitanate having a separation factor greater than 12,500 at an alkaline pH, and that the burden of proof is on Applicant to establish that the products disclosed by Cahill are patentably distinct. (See Office Action mailed July 23, 2004 at page 3).

In the decision *In re Best*, the United States Court of Customs and Patent Appeals restated the burden of proof required to overcome an inherency rejection. *Id.* at 1254-5 (citing *In re Swinehart*, 58 CCPA 1027, 439 F.2d 210, 169 USPQ 226 (1971)). The Court said:

[It] is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be

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critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This burden was involved in *In re Ludtke*, 58 CCPA 1159, 441 F.2d 660, 169 USPQ 563 (1971), and is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics.
In re Swinehart, 58 CCPA at 1031, 439 F.2d at 212-13, 169 USPQ at 229.

The Court also said that “[w]hether the rejection is based on ‘inherency’ under 35 USC 102, on ‘prima facie obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same . . .” *In re Best*, at 1255 (citing *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972)).

Applicant asserts that the products disclosed by Cahill and Honeywell do not possess the characteristics of the instantly claimed products. The Cahill disclosures deal with the ability of sodium nonatitanates to sequester strontium. (See Cahill, Abstract). Accordingly, the characteristics of the sodium nonatitanates prepared by Cahill were supposed to have a high affinity for strontium without regard for the affinity that the sodium nonatitanate would have for rubidium. Accordingly, Cahill did not calculate a separation factor between strontium and rubidium as set out in present claims.

Neither the sodium nonatitanate materials disclosed by Cahill nor the Honeywell product inherently possess the characteristic of having a strontium/rubidium separation factor greater than 12,500 at an alkaline pH as claimed by the Applicant in claim 1. A separation factor is defined in the specification at page 12, saying that separation factors for the strontium/rubidium selectivity are “calculated by dividing the strontium K_d by the rubidium K_d . . .” When calculating a strontium/rubidium separation factor, the strontium K_d and the rubidium K_d must be determined at the same pH.

Cahill describes sodium nonatitanate materials that exhibit a strontium/rubidium separation factor of about 10 under alkaline conditions (pH between 9.95 and 11.14). (See Cahill, p. 25, Table 2). This separation factor for the sodium nonatitanate product is determined by dividing the strontium K_d of 6,570 by the rubidium K_d of 658. *Id.* Even if the K_d value is adjusted to 20,000, as Cahill discloses may be possible, the separation factor is still only 30, *far below the separation factor that is greater than 12,500 at alkaline pH, as claimed by Applicant.*

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Therefore, the strontium/rubidium separation factor of the product disclosed by Cahill is much less than the separation factor claimed by Applicant in an alkaline pH.

Honeywell is referred to in the Applicant's specification as a product that was compared to the sodium nonatitanate products being claimed by Applicant. However, Applicant has already compared the strontium/rubidium separation factor provided by these separate products as set out in Table 5 (Specification pages 15-16). The sodium nonatitanate obtained from Honeywell yielded a strontium/rubidium separation factor of 12,500, whereas the sodium nonatitanate of the present claims yielded strontium/rubidium separation factors ranging from 59,200 to 141,000. This data clearly shows that the product claimed by Applicant is not the same as the Honeywell product.

Applicant claims that the sodium nonatitanate is characterized by a strontium/rubidium separation factor greater than 12,500 at an alkaline pH. While the specification does not expressly state a separation factor "greater than 12,500", an inventor may excise the prior art from the claim and still satisfy the written description requirement of section 112, first paragraph. *In re Johnson*, 558 F.2d 1008, 194 U.S.P.Q. 187 (C.C.P.A. 1977). Applicant asserts that it would be an absurdity for the law to require, and an impossible task to accomplish, that an applicant must expressly disclose everything that is not in her compositions or every step that is not included in her methods. The Honeywell product disclosed in Applicant's specification has a known strontium/rubidium selection factor of 12,500 at an alkaline pH. Applicant is merely excising the prior art from the claimed invention, thereby clearly describing the claimed invention and setting the bounds of the invention to exclude the known prior art of the Honeywell material.

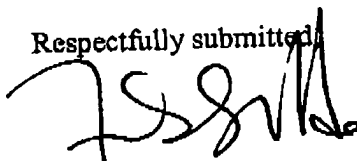
Therefore, because Applicant has permissively carved the prior art from the claimed invention and because the limitations claimed by Applicant are not disclosed, taught or suggested by the cited prior art, reconsideration and withdrawal of the rejection is respectfully requested.

Applicant respectfully asserts that all claims are now in condition for allowance and earnestly seeks a timely Notice of Allowance. If the Examiner determines that a telephone interview would expedite the examination of the pending application, the Examiner is invited to call the undersigned attorney. In the event there are additional charges in connection with the

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filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/LYNN/0119 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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